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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/228,821	01/11/99	WENZEL	3596.02-1

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EXAMINER

JOHNSON, J

ART UNIT PAPER NUMBER

1764

9

DATE MAILED: 05/30/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/228,821

Applicant(s)

Wenzel

Examiner

J. Johnson

Group Art Unit

1764

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 3/20/00.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1, 29-58 is/are pending in the application.
- Of the above claim(s) 29 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1 and 30-58 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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Applicant's election of Group I, claims 1-28, in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim 29 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention.

The abstract of the disclosure is objected to because the abstract exceeds 250 words. Correction is required. See MPEP § 608.01(b).

The incorporation of essential material in the specification by reference to "[a]ll patents, patent applications, articles, references, standards, etc. cited herein" (page 7, lines 12 and 13) is improper because only U.S. Patents and allowed U.S. Applications may be incorporated by reference. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1 and 30-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has not pointed to where in the disclosure there is support for the amended claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 30-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 30-58 are replete with indefinite and/or incorrect terms. Accordingly, it is impossible to determine just what is being claimed. Specifically:

Claim 1, and claims dependent thereon, are rendered indefinite by the recitation of Markush groups containing terms (a)(ii), (b)(ii) and (b)(iii) which, apparently, are only "optionally" recited. Normal Markush group practice means that any of the recited elements within the group may be selected, i.e., (a)(i), (a)(ii) or (a)(iii). Yet element (a)(ii) is apparently only "optionally" present. Thus it is unclear if the composition must contain at least component (a)(i) or, if, as normal Markush practice would allow, element (a)(ii) may be selected; (a)(ii)

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being “optional” (i.e., not being present). In component “c”, the recitation “wherein trialkylamines are excluded” is not understood. That limitation is recited within the Markush group of component “c”. It is unclear how the recitation “having a viscosity similar to that of the liquid combustible fuel” modifies, or is intended to modify, the recitation “where the ratio of combustible fuel:additive ranges from about 50:50 to 99:1 by volume”. Especially considering that claim 1 does not contain “combustible fuel”. The term “having a viscosity similar to that of the original viscosity of the fuel” is subjective and indefinite. Additionally, defining the additive composition by reference to a microemulsion which excludes certain components renders the claims indefinite. The recitation “R<sub>4</sub> is alkylphenyl of 1 to 18 carbon atoms in the optionally branched alkyl chain or H” is indefinite. Claim 1 is rendered indefinite by the recitation that the composition excludes “aromatic organic compounds” and also excludes “compounds of phenanthrene”, i.e., phenanthrene is an aromatic organic compound. The recitation “and other organic diacids” on page 4, line 2 of the amendment, is indefinite, i.e., fails to particularly point out and distinctly claim which “other diacids” are intended. The recitation of the proviso that “when the additives for diesel fuel are anhydrous, component (c) is optional” renders the claims indefinite, i.e., claim 1 recites “one or more of the following components selected from (b), (c) or combinations of (b) and (c)”. Thus it is unclear if component (c) is an optional component or, is a required component when the additives are not anhydrous and for diesel fuel.

Claims 32, 38 and 44 fail to further limit the additive composition.

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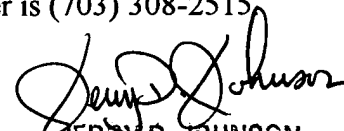
Applicant's arguments filed March 20, 2000 have been fully considered but they are not persuasive.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (703) 308-2515.

JDJ  
May 29, 2000

  
JERRY D. JOHNSON  
PRIMARY EXAMINER  
GROUP 1100